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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/501,526 | 07/16/2004 | Tsuyoshi Komuro | 5553KO1-1 | 7145 |
| 62574 | 7590 | 03/20/2009 | EXAMINER | |
| Jason H. Vick Sheridan Ross, PC Suite # 1200 1560 Broadway Denver, CO 80202 | | | UBER, NATHAN C | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3622 | |
| | | | NOTIFICATION DATE | DELIVERY MODE |
| | | | 03/20/2009 | ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jvick@sheridanross.com

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/501,526 | Applicant(s) KOMURO ET AL. | |
| | Examiner NATHAN C. UBER | Art Unit 3622 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6,11 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,11 and 21-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7 January 2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in reply to the amendment filed on 7 January 2009.
2. Claims 1, 2, 4, 5, 6 and 11 have been amended.
3. Claims 21-23 have been added.
4. Claims 3, 7-10 and 12-20 have been canceled.
5. Claims 1, 2, 4, 5, 6, 11 and 21-23 are currently pending and have been examined.

Information Disclosure Statement

6. The Information Disclosure Statement filed on 7 January 2009 has been fully considered. An initialed copy of the Form 1449 is enclosed herewith.

Claim Objections

7. Claims 15 and 17 were objected to because they are improper dependent claims. The claims were canceled rendering the objections moot.
8. Claims 9 and 18-20 were objected to because they are improper dependent claims under 35 U.S.C. 112 4th paragraph. The claims were canceled rendering the objections moot.
9. Claims 9 and 18-20 were objected to because they are in improper sequence. The claims were canceled rendering the objections moot.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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11. Claims 1, 2 and 4-6 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The limitation *means for outputting information showing which content portion of the content portions which are combined with the advertisement portion is effective for the advertisement by comparing number of distribution for combinations of the content portions and the advertisement portion* was has been excised from the claims. The rejection is therefore moot.
12. The following is a quotation of the second paragraph of 35 U.S.C. 112:
- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
13. Claims 1, 2 and 4-6 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation *means for outputting information showing which content portion of the content portions which are combined with the advertisement portion is effective for the advertisement by comparing number of distribution for combinations of the content portions and the advertisement portion* was has been excised from the claims. The rejection is therefore moot.
14. Claims 2, 4, 6 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 2, 4, 6 and 11 recite the limitation "the distributing means" in the limitation disclosing recordation of the distribution log. There is insufficient antecedent basis for this limitation in the claims.

Claim Rejections - 35 USC § 101

15. 35 U.S.C. 101 reads as follows:
- Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
16. Claims 1 and 6 were rejected because the claims were directed to non-statutory subject matter. The rejections are withdrawn.

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17. Claim 11 was rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. This rejection is maintained. Based on Supreme Court precedent, a method/process claim must (1) be tied to a particular machine or apparatus (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claim 11 fails to meet the above requirements because it is not tied to a particular machine or apparatus and because it does not transform underlying subject matter.

Claim Rejections - 35 USC § 102

18. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

19. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or

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part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

20. Claims 1, 2, 4-6, 11 and 21-23 are rejected under 35 U.S.C. 102 (e) as being anticipated by Holtz et al. (U.S. 6,760,916).

Claims 1, 2 and 23:

Holtz, as shown, discloses the following limitations:

- *means for storing the content, wherein each content is correlated with a main content indicator that indicates the main content comprised in the content and an advertisement indicator that indicates the advertisement included in the main content (see at least column 19, lines 61-63; see also at least column 24, lines 42-44),*
- *means for distributing the contents (see at least column 25, line 23-26),*
- *means for recording a distribution log at the time of execution of the distributing means wherein the distribution log has the number of times each content is distributed and the distribution log has the main content indicator and the advertisement indicator of the distributed contents (see at least column 37, lines 10-42, logging ad distribution, monitoring number of "hits," counting hits and retiring an ad when the maximum hits have been achieved, noting which ad is distributed, see also other data logged),*
- *means for outputting information on each number of times of distribution of each main contents including the same advertisement by selecting the data from the distribution log based on the advertisement indicator, so that it can be judged which main content which included the advertisement ins effective for the advertisement by comparing the numbers of distribution contained in the output information (see at least columns 37-38, lines 67 and 1-17, generating customized reports detailing logged information for advertisers).*

Claims 4 and 11:

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Holtz, as shown, discloses the following limitations:

- *a central processing unit (CPU) of the content distribution device is to execute the procedures of (see at least Figure 1),*
- *storing the content wherein each content is correlated with a main content indicator that indicates the main content comprised in the content and an advertisement indicator that indicates the advertisement included in the main content (see at least column 19, lines 61-63; see also at least column 24, lines 42-44),*
- *distributing the content; and (see at least column 25, line 23-26),*
- *recording a distribution log at the time of execution of the distributing means, wherein the distribution log has the number of times each content is distributed and the distribution log has the main content indicator and the advertisement indicator of the distributed contents (see at least column 37, lines 10-42, logging ad distribution, monitoring number of "hits," counting hits and retiring an ad when the maximum hits have been achieved, noting which ad is distributed, see also other data logged),*
- *outputting information on each number of times of distribution of each main contents including the same advertisement by selecting the data from the distribution log based on the advertisement indicator, so that it can be judged which main content which included the advertisement ins effective for the advertisement by comparing the numbers of distribution contained in the output information (see at least columns 37-38, lines 67 and 1-17, generating customized reports detailing logged information for advertisers).*

Claims 5 and 6:

Holtz, as shown, discloses the following limitations:

- *means for recording a distribution log at the time of execution of the means, wherein the distribution log has the number of times each content is*

distributed and the distribution log has the main content indicator and the advertisement indicator of the distributed contents (see at least column 37, lines 10-42, logging ad distribution, monitoring number of "hits," counting hits and retiring an ad when the maximum hits have been achieved, noting which ad is distributed, see also other data logged),

- *means for outputting information on each number of times of distribution of each main contents including the same advertisement by selecting the data from the distribution log based on the advertisement indicator, so that it can be judged which main content which included the advertisement is effective for the advertisement by comparing the numbers of distribution contained in the output information (see at least columns 37-38, lines 67 and 1-17, generating customized reports detailing logged information for advertisers).*

Claim 21:

Holtz, as shown, discloses the following limitations:

- *said main content is a promotion video of artist's musical composition (see at least column 7, lines 1-33, content is video content comprising entertainment portion (news) and promotional material added to the video and related to the video).*

Claim 22:

Holtz, as shown, discloses the following limitations:

- *said promotion video comprises an image that the artist is enjoying a product or service to be advertised so that the advertisement is dependently included in the promotion video (see at least column 7, lines 1-33, content is video content comprising entertainment portion (news) and promotional material added to the video and related to the video).*

Examiner Notes: With respect to claims 21 and 22, the nature of the content, i.e. the content is a music video and included an artist enjoying the advertised product, does not

patentably affect the scope of the invention. Such data is considered non-functional descriptive data (see MPEP §2106).

Response to Arguments

21. Applicant's arguments filed 7 January 2009 have been fully considered but they are not persuasive. Applicant first argues that Holtz does not disclose the same content. Applicant argues "Holtz merely discloses the advertisement is linked to the main content and does not disclose *the content comprises a main content in which an advertisement is dependently included, for example, the promotion video (the main content) comprises an image that the artist is enjoying a product or service...*" (emphasis added) (see at least page 8 of Applicant's arguments). As noted in the rejection above, Holtz discloses two types of content, ad content and main content (see at least column 19, lines 61-63; see also at least column 24, lines 42-44). Further Applicant's claim is not limited to one specific type of advertisement as in Applicant's example which refers only product placement-type ads.
22. Applicant argues further that "Holtz fails to disclose that the device outputs information on each number of times of distribution of each main contents..." (see at least page 8 of Applicant's arguments). As noted in the rejection above, Holtz discloses counting the number of ad distributions in many different ways including counting views, clicks etcetera and presenting this data to the advertiser in a number of customizable reports. Examiner reminds Applicant that in preparing the response, Applicant should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passages as taught by the prior art or disclosed by the Examiner.

Conclusion

- 23.** The rejections are maintained in this Office action and have been updated to reflect Applicants Amendments. New rejections presented in this Office action were necessitated by Applicants amendments and the addition of new claims. All of Applicant's arguments are addressed above. Accordingly, **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
- 24.** A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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25. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Eric Stamber** can be reached at **571.272.6724**.
26. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).
27. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

P.O. Box 1450, Alexandria, VA 22313-1450

or faxed to **571-273-8300**.

28. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

Randolph Building

401 Dulany Street

Alexandria, VA 22314.

/Nathan C Uber/ Examiner, Art Unit 3622
16 March 2009

/Arthur Duran/
Primary Examiner, Art Unit 3622